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IN THE

Supreme Court of the United States

Term, 19

No. ~~992~~ 132

INTERNATIONAL LATEX CORPORATION,

Petitioner,

v.

THE WARNER BROTHERS COMPANY,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

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INTERNATIONAL LATEX CORPORATION,
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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, International Latex Corporation, respectfully prays that a writ of certiorari issue to the United States Circuit Court of Appeals for the Second Circuit to review a judgment of that court entered March 11, 1960.

A certified transcript of record, including the proceedings in said Circuit Court of Appeals, has been filed herein pursuant to Rule 21(1) and (3).

The opinions in the courts below

Court of Appeals, Second Circuit, March 11, 1960, reported in 276 F. (2d) 557; 124 USPQ 479 (II, 102a) and United States District Court, District of Connecticut, Anderson, District Judge, January 13, 1959, reported in 169 F. S. 755 (I, 370a).

Grounds on which jurisdiction of this Court is invoked:

The suit arises under the Federal patent laws.

(i) The judgment of the Court of Appeals was entered March 11, 1960 (II, 118a).

(ii) Rehearing was denied on March 29, 1960 (II, 128a).

(iii) The jurisdiction of this court is invoked under Title 28 U. S. Code §1254(1). The jurisdiction of the courts below is based on 28 U. S. C. §1338(1) and §1292(4).

The Question Presented for Review:

Whether, in a patent for a significant invention, the doctrine of equivalents is applicable to the interpretation of a restricted claim, granted after rejection and cancellation of a broader claim, where such interpretation does not have the effect of recovering matter ceded in the Patent Office?

The facts material to the consideration of the question presented:

Petitioner, International Latex Corporation, sued The Warner Brothers Company in the United States District Court for the District of Connecticut for infringement of claims 1, 2 and 6 of Spanel patent 2,360,736 for a seamless dipped latex girdle.

The trial court held claims 1, 2 and 6,* valid but not infringed, interpreting the claim language calling for slightly roughened or matted inside surfaces of the deposited latex girdle to exclude "any kind of alien material attached to the surface of the deposited latex, such as flocking which is used by both plaintiff and defendant * * *"; and rejecting plaintiff's invocation of the doctrine of equivalents on the ground of file-wrapper estoppel, 169 F. S. 758, 762-3, 765 (I, 385a-387a, 390a).

The Second Circuit Court of Appeals affirmed, 276 F. 2d 557 (II, 102a, 111a-117a).

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* "1. An integral one-piece supporting girdle formed of deposited latex sheet material of a strength and shape throughout to apply constrictive force to the flesh around the lower torso of the wearer, the external surfaces of said sheet material being smooth and the inside surfaces thereof being of a slightly roughened matted character for contact with the skin of the wearer.

"2. An integral one-piece supporting girdle formed of deposited latex sheet material of a strength and shape throughout to apply constrictive force to the flesh around the lower torso of the wearer, the internal surfaces of said sheet material being of a matted character and such as to provide in contact with the skin an interconnected cellular formation.

"6. An integral one-piece supporting girdle formed of deposited latex of a strength and shape throughout to apply generally uniform constrictive force to the flesh around the lower torso of the wearer, the front and back areas being formed with 'pin-point' perforations distributed thereover, and the inside surfaces of the latex being of a slightly roughened matted character."

The Spanel invention

"The invention disclosed by the Spanel patent was an integral one-piece girdle of deposited latex 'of a strength and shape throughout to apply constrictive force to the flesh around the lower torso of the wearer'."* "There was immediate and constantly increasing public acceptance of the Spanel girdle once it was put on the market" (I, 384a). The success of plaintiff's "Playtex" girdle was so marked that it led defendant's marketing expert in 1952 to say that it was "very rapidly becoming the outstanding basic staple in the foundation garment field" and to recommend "that every effort be made to design or create a similar garment" for defendant (I, 234a; 174-5a).

"The accused girdles are similar to plaintiff's patented product under Claims 1, 2 and 6 of the patent, except for the character and composition of the inside of the girdle * * *" (Finding 41; I, 378-9a).

The patent discloses, as a preferred form, a girdle whose inner surface is matted or slightly roughened to produce "a better feel to the skin and better moisture absorbent qualities" (Appendix, Note 2). "This roughened inner surface of the girdle may be produced," the patentee says, "by roughening the surface of the form on which the girdle is generated." Page 6, col. 1, lines 29-35 (I, 342a). This mold-roughening procedure for roughening the inner girdle surfaces was no part of the patentee's invention. It was "very old art," 169 F. S. 762 (I, 384a). There was also available in the prior art a second procedure for producing such a matted or roughened surface, called "flock-

* See Finding 18, 169 F. S. 758 (I, 375a), and the affirming discussion by the Court of Appeals, 276 F. 2d 557, 559 (II, 104a-105a) printed in Note 1 of an Appendix for convenient reference.

ing," in which through a prior art process fine particles of fabric, such as cotton, rayon, wool or other similar material, are applied to the deposited latex of the inside surface of the girdle before the latex has hardened (Appendix, Note 3).

At first plaintiff's girdles had a smooth inner surface. Later plaintiff used flocking to provide a matted or roughened inner surface, a practice which defendant followed when it subsequently adopted the integral latex girdle disclosed in the patent (I, 168-9a).

The Patent Office history of the claims

Of the claims in the patent application as filed, some were broad enough to cover the invention without limitation as to the texture of inner surfaces, *e.g.* claim 24 (Appendix, Note 4). Others were, like the patent claims 1, 2 and 6, restricted to roughened inside surfaces, *e.g.* claims 26 and 27 (Appendix, Note 5).

All the claims were initially rejected. After various changes in form rather than in substance the applicant cancelled the broader claims and the narrower claims were allowed.

Nowhere in the course of the Patent Office proceedings was any emphasis placed on the *procedure* for producing a roughened inside surface nor was the language used to describe the roughened or matted inside surface a matter of concern. There is no indication that the allowance of claims was dependent in any way on the particular language used in this regard.

Having however relinquished the broad claims to the girdle *per se* without limitation as to the character of the inside surface, the patentee and your petitioner are bound by that disclaimer.

Neither in urging an interpretation of claims 1, 2 and 6 that does not exclude flocking, nor in seeking inclusion of flocking under the doctrine of equivalents, has it been sought to recover ground ceded in the Patent Office.

The Court of Appeals said, 276 F. 2d 564 (II, 115a):

> "Plaintiff is right in asserting that when it asks us to apply the doctrine of equivalents to include flocking within claims 1, 2 and 6, it is not seeking to produce the result, * * * of recovering ground that Spanel had ceded in the patent office—as would be the case if it were contending that a smooth inner surface girdle was the equivalent of a roughened one."

Argument amplifying the reasons relied on for the allowance of the writ

The special and important reason relied on for the allowance of the writ is that the Court of Appeals has decided an important question of patent law in conflict with applicable decisions of this Court.

Its judgment brings into question basic principles of patent claim interpretation upon which the doctrine of equivalents rests and, more particularly, the application of that doctrine where the accused embodiment is outside the literal verbalism of the claims or is not an alternative expressly disclosed in the patent specification, although available in the art.

These principles are:

Point 1. That where the court has found that the alleged discovery or invention has advanced the art substantially, then the court is liberal in its construction of the patent to give to the inventor the award he deserves, *Eibel Co.* v. *Paper Co.*, 261 U. S. 45, 63, and in a case of doubt where the claim is fairly susceptible of two constructions will adopt that one which preserves to the patentee his actual invention. *Smith* v. *Snow*, 294 U. S. 1, 6.

Point 2. That even if the alleged infringement does not fall within the literal language of the claims, the doctrine of equivalents is available to embrace it in circumstances such as those presented here, lest verbalism replace the wholesome realism of the doctrine and by subordinating substance to form defeat the primary purposes of the patent system. *Graver* v. *Linde*, 339 U. S. 605, 607-8.

Point 3. That under the doctrine of file wrapper estoppel these basic rules of interpretation remain applicable to claims restricted in the Patent Office so long as inclusion of known equivalents of elements defined in those claims does not have the effect of recovering ground ceded by the applicant. *Exhibit Supply Co.* v. *Ace Corp.*, 315 U. S. 126, 134-5.

Point 4. That to establish file wrapper estoppel it must appear that the subject matter [in this case the choice of a particular type of slightly roughened or matted inner surface of the latex girdle] was embraced within the subject of discussion between the examiner and the applicant.

Exhibit Supply v. *Ace, ante; Bird* v. *Sears, Roebuck Co.*, 299 F. 574, 576 (CCA 2).*

The *ratio decidendi* of the Court of Appeals

The Court, saying 276 F. 2d 562-3 (II, 112a), "Plaintiff's interpretation of the claims to include flocking is inadmissible," emphasizes that in the claims "nothing suggests the roughened surface is to be part latex and part something else."

Turning to the specifications it correctly found in the patentee's phrase "the inside surface of the latex walls of the girdle preferably has • • • a texture • • • of a more matted character," nothing suggesting the addition of something else to the latex surface; and, as "even more significant," that the roughening procedure disclosed roughened the surface of the deposited latex without the addition of anything else, and that "nowhere, in the 114 pages of the file, would a searcher encounter a single reference to flocking."

Although this emphasis is, we submit, irrelevant to the issue, which does not depend on whether the specifications do or do not suggest "the addition of something else", there is nothing factually wrong with this recital. The patentee did not anywhere specifically disclose or suggest any other way of roughening than the mold-roughening.

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* If review in this Court is granted, it will be submitted on petitioner's behalf, and supported by citations, that the history of adjudication of the doctrine of file wrapper estoppel shows consistent recognition of this requirement by this Court and by the Courts of Appeals. See, for instance, the classic exposition and review of this familiar rule by Judge Putnam in *Reece* v. *Globe*, 61 F. 958, 968-970.

which added nothing but roughness to the deposited latex. In the 114 pages of the file there is, beyond the specification of the patent itself, no reference to flocking or to mold-roughening or to any other way of roughening the latex surface. The specifications did not go beyond the disclosure of one way in which it might be done. The roughening *procedure*, which was no part of the invention, never in any way entered into the discussions between the applicant and the Patent Office examiner.

It was against this background that the Court concluded that "plaintiff's interpretation of the claims to include flocking is inadmissible" and said:

> "Plaintiff can therefore prevail as to infringement on claims 1, 2 and 6 only if this is a proper case for applying the doctrine of equivalents." 276 F. 2d 563 (II, 113a)

Approval withheld from trial court on equivalence as a matter of fact

At this point in its opinion the Court of Appeals turned to Judge Anderson's finding that "Even if the doctrine were not ruled out as a matter of law, 'flocking' as used in the accused girdles is not in fact the equivalent of the roughened or matted internal surfaces of the girdles as described in the patent claims."

From this the Court of Appeals withheld approval. It said: "Admittedly the two processes serve the same objectives—promoting evaporation, lessening too close a sticking to the skin, and giving a softer and more comfortable feel." 276 F. 2d 563 (II, 113a); and as to Judge Anderson finding that flocking is superior to roughened or matted latex surfaces without flocks, and "more ex-

pensive than the process of roughening contemplated by the patent"* it commented, 276 F. 2d 563 (II, 113a-114a):

> "And neither the superiority of flocking nor its being more expensive, in an unstated degree, would require a determination that it passed the bounds of equivalence in a proper case. (citing cases) We should thus have difficulty in saying that under no circumstances could flocking be deemed an equivalent for abrading the inner surface of latex; however, that issue is an unreal one, arising out of the attempted dichotomy of 'equivalence' as between fact and law. The only question of interest to the parties is whether flocking is to be treated as an equivalent under the circumstances here. We think not."

Thus the Court of Appeals rested its judgment not on lack of equivalence as a matter of fact but rather on "the circumstances here"; that is to say, because the claims were "drastically narrowed" in the Patent Office.

The practical effect of the Court's judgment was to strip the patentee and your petitioner of all realistic monopoly right to the invention. This complete emasculation of a patent for a concededly significant invention used by the defendant, on the sole ground that defendant had replaced by a known substitute *procedure* the roughening procedure mentioned in the patent when the surface roughening procedure was no part of the invention, must have, we think, a shocking incidence on anyone. It seems to have left a feeling of shock with the Court of Appeals itself. Agreeing with plaintiff's counsel that the inventor Spanel was left with nothing but the glory of the invention, the Court said, 276 F. 2d 565 (II, 117a):

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* 169 F. S. 755, 763-4 (I, 387a-388a).

> "Plaintiff's disappointment is understandable. But the result stems from Spanel's decision not to appeal the examiner's rejection of the claims embodying his basic invention but rather to accept a patent with *exceedingly* narrow and restricted claims." (Emphasis supplied.)*

Application of the doctrine of equivalents refused.

The Court of Appeals then turned, in its opinion, directly to the applicability of the doctrine of equivalents under the circumstances of the case at bar, and developed the reasoning by which it reached the conclusion of non-infringement.

The Court refers to the opinion written by Judge Learned Hand in *Royal* v. *Remington*, 168 F. 2d 691, 692, as emphasizing "the necessarily imprecise nature of the doctrine" and to Judge Hand's opinion in *Deitel* v. *Unique*, 54 F. 2d 359, 360, in which application of the doctrine of equivalents was found to be inappropriate, as showing "how small the benefit appropriate in a particular case may be" and concluded (II, 114a):

> "We think a similar result ought [to] follow when, as here, although the invention may have been broader, the applicant *drastically* narrowed his claims to overcome difficulties in the Patent Office." (Emphasis supplied.)

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* We emphasize the adverb "exceedingly" and the later use of "drastically" because they expose a turn of the thinking of the Court of Appeals away from the question whether in the file wrapper there was evidence of surrender of the concrete subject matter here sought to be reached, toward a wholly subjective unmeasured judgment that the claims allowed were "exceedingly" or "drastically" narrowed. It was this wrong turn that led to the shocking practical impact of the Court's judgment.

The Court regarded Judge Hand's opinion as to claim 19 in *Intercontinental* v. *Sterilek*, 94 F. 2d 10, at 11-12, as "at least a signpost along that road"; perhaps because it cited *Deitel*.

Then, after noting that plaintiff is not seeking to recover "ground that Spanel had ceded in the Patent Office" the Court nevertheless—adopting a phrase from another opinion of Judge Learned Hand—said (R. 115a):

> "Nonetheless we think it would be incongruous to apply an equitable doctrine, which is 'in misericordiam to relieve those who have failed to express their complete meaning,' *Claude Neon Lights* v. *E. Machlett & Son*, 36 F. 2d 574, 576 (2d Cir. 1929)." *

The decision of this Court in *Graver*

Coming finally to consideration of the decision of this Court in *Graver*, the Court of Appeals finds that decision not inconsistent with its conclusion here because (1) the alternative in *Graver* had been disclosed in the specification** and (2) because the alternative was embraced in a

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* This characterization of the doctrine of equivalents as "in misericordiam" evidences again the Court's wrong turn away from the obligation to find in the Patent Office proceedings concrete evidence of consideration of the subject matter of the alleged estoppel, toward abstract judgment, unsupported by any such evidence, of the patentee's deserts at the mercy seat. We submit that the doctrine of equivalents is not a doctrine of commiseration, pity or mercy oriented toward the patentee or the patent owner, but is a doctrine whose principle and purpose is to guard against converting the "protection of the patent grant into a hollow and useless thing," primarily for the general welfare and only secondly for doing justice to the patent owner. *Graver* v. *Linde*, 339 U. S. 605, 607-8.

** But compare *Exhibit Supply Co.* v. *Ace Corp.*, 315 U. S. 126, where this Court confronted with file wrapper estoppel interpreted the restrictive words "embedded in the table" to include nails driven into the table although no such embodiment was disclosed in the patent.

broad claim granted by the Patent Office but ultimately declared invalid, 276 F. 2d 564 (II, 115a)—a fact that excluded file wrapper estoppel.

At this point, the Court makes reference to a footnote 49 in an article "The Doctrine of Equivalents Revalued," 19 Geo. Wash. L. Rev. 491, 502. That footnote reads as follows:

> "In theory, much of the dissent of Justice Black in the Graver Tank case appears well founded, but the dissent appears totally to ignore the presence of a broad claim in the patent as issued. Were it not for the broad claim, the arguments of the dissent would be difficult to overcome. But, with the broad claim present, it is difficult to find the dedication to the public upon which the dissent appears to be based."

Finally the Court of Appeals adds to its opinion the following footnote, 276 F. 2d 564 (R. 116a):

> "The same note concludes (p. 497) that where the hardship to the patentee relied on as a basis for invoking the doctrine of equivalents stems from limitation of claims as a result of prosecution before the patent office, the case 'is not such as to warrant aid from the doctrine but instead is more properly viewed as a condition resulting from the patentee's own mistakes of judgment * * * even though the extent of financial loss to the patentee may be extreme.'"

Conclusion

For the purpose of this petition we have thus reviewed the legal reasoning on which the Court of Appeals based its judgment that the claims in issue must be so limited as to exclude a roughened surface unless it is all latex and not part latex and part something else.

We have urged that the decision below puts again in doubt principles and policies of patent claim interpretation established by the decisions of this Court * and reflects a rejection of the wholesome realism expressed by Justice Jackson in *Graver* (339 U. S. 606, 607)

> "Outright and forthright duplication is a dull and very rare type of infringement. To prohibit no other would place the inventor at the mercy of verbalism and would be subordinating substance to form. It would deprive him of the benefit of his invention and would foster concealment rather than disclosure of inventions which is one of the primary purposes of the patent system."

The basic error of the Court lay in its holding that the doctrine of equivalents is not available in the interpretation of narrowed claims even though such interpretation would not have the result of recovering ground ceded in the patent office but would cover merely known alternatives of the elements claimed. The practical effect in this case was to emasculate the patent for a significant invention. In general application, the decision sets a precedent having

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* The decision might even be advanced, we suppose, to support the idea that "The doctrine of equivalents had changed from a routine tool of the patent courts to an equitable last resort * * *," to use the author's words at page 504 of the George Washington Law Review article referred to by the Court of Appeals.

potentialities of great harm to the patent system, since in the great majority of cases, the claims as originally presented are narrowed to a greater or less degree in the patent office. To arbitrarily deny narrowed claims the benefit of the doctrine of equivalents is, in substantial effect, to nullify the doctrine itself with the result, of great economic significance, that most patent rights will be thrown into an area of doubt capable of converting "the protection of the patent grant into a hollow and useless thing." *Graver* v. *Linde*, 339 U. S. 605, 607.

Additionally we will urge if the writ is granted that the rigid verbalism of the court's interpretation of claims 1, 2 and 6 to exclude the addition of "something else" violates the principles announced in the *Eibel* and *Smith* case (Point 1, *ante* p. 7) and the subordinate rule of *Elizabeth* v. *Pavement*, 97 U. S. 126, that the addition of something else to the claimed subject matter, even though an improvement, does not escape infringement.

Respectfully submitted,

WILLIAM H. DAVIS
Attorney for Petitioner

New York, N. Y., June 7, 1960

APPENDIX

Note 1

"The novelty of Spanel's conception, which was the basis of the patent in suit * * * [lay] * * * in a thought that for the first time made a seamless latex garment feasible as a girdle. * * * As set forth in the patent, Spanel found that by using a liquid latex material for the walls of the girdle 'considerably thicker than has been heretofore usually employed in the manufacture of garments from liquid latex,' * * * he * * * could produce a garment which, as the District Court found, 169 F. Supp. 758, 120 USPQ at 151, 'supports and constricts the wearer's torso, giving a firm, slimmed appearance, without markedly restricting freedom of movement.' " 276 F. 2d 559, 561 (II, 104a-105a)

"We agree with the District Court that the patent is valid because of the invention in Spanel's basic concept. * * *

"Although the prior art had disclosed the advantages of using rubber in garments for constricting purposes and the feasibility of seamless latex objects in general, Spanel was the first to develop a seamless latex girdle having such features of thickness, tensile strength, shape and size that the garment would produce the desired shaping effect on the wearer's body although, or rather because, the garment was not tailored to the particular form of the body." 276 F. 2d 562 (II, 110a)

And see the trial judge's discussion at 169 F. S. 761-2 (I, 382a-384a).

Note 2

"Moreover, according to the invention, the inside surface of the latex walls of the girdle preferably has a less smooth texture than the outside, which texture, being of a more 'matted' character, tends to produce a better feel to the skin and better moisture absorbent qualities.

"It is desired to produce a very decided difference of texture between the inside surface of the girdle and the outer surface thereof, and the invention also contemplates a girdle made from liquid latex having a smooth outer surface and a roughened inner surface next to the skin." Page 6, column 1, lines 18-35 (I, 342a)

Note 3

Finding 43. "The accused girdles differ from the plaintiff's patented girdle as described in Claim 1, 2 and 6, in that they are 'flock lined,' i.e. through a prior art process, fine particles of fabric such as cotton, rayon, wool or other similar material are applied to the latex of the inside surface of the girdle." 169 F. S. 760 (I, 379a)

"defendant's girdles accomplished the departure from smoothness in the interior surface, desired to promote evaporation and provide a more comfortable 'feel,' not by abrading the surface of the latex, as Spanel had taught, but by a process, known as 'flocking,' which applies fine particles of fabric such as cotton, rayon or wool before the latex has hardened. Plaintiff likewise has used 'flocking' on all its girdles which do not have smooth inner surfaces": 276 F. 2d 561 (II, 109a)

Note 4

Original claim 24. "As an article of manufacture, a hollow, deposited, latex, supporting girdle, adapted when placed in position on the lower portion of the human torso to stretch thereon to form a continuous, stretched, skin-like, relatively smooth surface, while supporting the body of the wearer." (File History, Def. Exh. L, p. 24)

Note 5

Original claim 26. "As an article of manufacture a hollow, latex, supporting girdle provided with walls adapted to enclose a portion of the body of the wearer, the outsides of said walls presenting smooth surfaces, while the insides of said walls which are adapted to be contiguous to the skin of the wearer, present roughened surfaces.

Original claim 27. "As an article of manufacture a hollow, latex, supporting girdle provided with walls perforated by a plurality of small openings extending from the outside of said walls to the interior thereof, the outside of said walls presenting smooth surfaces while the inside of said walls present rough surfaces." (File History, Def. Exh. L, p. 25)

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ADDENDUM TO PETITION

Containing Opinion and Judgment of United States Court of Appeals for the Second Circuit

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* NOTE: Paging follows paging of Volume II of certified copy of transcript and that used in Petition in referring to documents in this Addendum.

Opinion

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

No. 79—October Term, 1959.

(Argued January 7, 1960 Decided March 11, 1960.)

Docket No. 25560

INTERNATIONAL LATEX CORPORATION,
Plaintiff-Appellant-Respondent.

v.

THE WARNER BROTHERS COMPANY,
Defendant-Respondent-Appellant.

Before:

LUMBARD, *Chief Judge*,
MOORE and FRIENDLY, *Circuit Judges*.

Action for infringement of Spanel patent No. 2,360,736 relating to seamless latex girdles. The District Court for Connecticut, Robert P. Anderson, *Judge*, held, 169 F. Supp. 755, the patent was valid but not infringed as to claims 1, 2 and 6 and valid and infringed as to claim 3. Plaintiff appeals from the judgment dismissing the complaint as to claims 1, 2 and 6; defendant appeals from the judgment of liability on claim 3. Judgment affirmed as to claims 1, 2 and 6 and reversed as to claim 3.

SIMON H. RIFKIND (Jay H. Topkis, Paul, Weiss, Rifkind, Wharton & Garrison; William H. Davis, George E. Faithfull, Davis, Hoxie, Faithfull & Hapgood, New York, N. Y., on the brief), *for Plaintiff-Appellant-Respondent.*

STEPHEN H. PHILBIN (E. Cummings Sanborn, Pullman, Comley, Bradley & Reeves, Bridgeport, Conn. and Fish, Richardson & Neave, New York, N. Y., on the brief), *for Defendant-Respondent-Appellant.*

FRIENDLY, *Circuit Judge*:

International Latex Corporation, a Delaware corporation, assignee of Spanel patent No. 2,360,736 for a seamless dipped latex girdle, brought this action against The Warner Bros. Company, a Connecticut corporation, for infringement. The case was tried in the District Court for Connecticut before Judge Anderson who, in a carefully reasoned opinion, 169 F. Supp. 755 held that the patent was valid and that it had been infringed as to claim 3 but not as to claims 1, 2 and 6. We agree that the patent was valid but that claims 1, 2 and 6 were not infringed. We have come to the same conclusion as to claim 3.

I. *The History*

Spanel's patent was for an improvement in women's girdles. The patent application, filed in June, 1940, sets forth the history of the art, most of this in a manner not seriously challenged. It describes the elaborate stiffened corset typical of the Victorian era; this, it states, was modified and ultimately discarded in favor of the girdle. Until Spanel's invention girdles were "generally made of

elastic textile fabric or panels of diverse material such as elastic fabric, textile fabrics and the like." One-piece girdles made of such fabric are known as "one-way or two-way stretch girdles"; they stretch only with these limitations as distinguished from the omnidirectional stretch of Spanel's latex girdle. According to Spanel, while such fabric girdles gave "considerable satisfaction in use," they were subject to certain disadvantages—among these that such girdles took "a relatively long time to wash and especially to dry, so that the wearer is often required to own at least two of the girdles in order to keep one in clean condition," that they tended "to leave welts, ridges, cross markings or other markings on the skin," and that they were "relatively expensive and also tend to lose their shape and elasticity rather rapidly, especially if washed often."

Latex, the milky fluid procured by tapping the rubber tree, seemed to offer a possible escape from these difficulties. Until the 1920's the usual procedure was to turn the latex fluid into crude rubber; this was then "masticated" into sheet or liquid form. In 1924 girdles made of sheet rubber panels sewn together achieved a vogue, but, as stated in one of defendant's publications, "the 'rubber corset boom' burst with a violence equal to its original blowing," since the garments proved uncomfortable or defective in numerous respects. About 1920 improvements in the techniques of preservation and transportation made it possible to keep the milky latex gathered at the tree in liquid form and bring it to the site of manufacture so that articles might be made by dipping a form or mold into a tank containing the liquid latex. Such dipping is an old art.

The novelty of Spanel's conception, which was the basis of the patent in suit, did not lie in the use of liquid latex rather than sheet rubber and the avoidance of seams, both

of which were indicated by the prior art, but in a thought that for the first time made a seamless latex garment feasible as a girdle. Plaintiff's witness Ambrose testified that before 1940 the girdle art "was oriented in the direction of selectivity applying constriction on the body." This "tailoring tradition," as plaintiff's counsel describes it, was a deterrent to the manufacture of a seamless latex girdle. Not only was it impracticable to manufacture or market latex girdles moulded to every variation of the female form, there was testimony that such a girdle "wouldn't mold and wouldn't flatten the bulges out." As stated by plaintiff's witness, Spanel "took the reverse twist. He was very much interested in a uniformity of your stresses, a multi-directional type of stretches, a multi-directional type of force, and a uniform type of stresses, instead of trying to intensify in certain areas." As set forth in the patent, Spanel found that by using a liquid latex material for the walls of the girdle "considerably thicker than has been heretofore usually employed in the manufacture of garments from liquid latex," in the range of about 16/1000 to 30/1000 of an inch, he obtained a material having a uniform stretch "in every direction in any given square centimeter of area." He discovered also that by using this material in a flat form following the contours of the body only to a limited extent, he could produce a garment which, as the District Court found, 169 F. Supp. 758, "supports and constricts the wearer's torso, giving a firm, slimmed appearance, without markedly restricting freedom of movement." Among the advantages claimed by Spanel for his girdle were higher tensile strength and consequently lighter weight than the crude rubber girdle; the absence of seams; more evenly distributed constricting effect, giving the wearer the lines of her own figure "'slimmed down' and properly formed"; a smooth outer surface resulting in a

smooth contact with garments worn immediately over the girdle so that these would not tend to "ride up"; and a great reduction in the number of size models required, with attendant savings in manufacturing and merchandising costs.

Spanel's girdle had a stormy voyage through the patent office; as will later appear, the details of this have an importance requiring a somewhat tedious summary.

As filed, the application contained 35 claims. Most of these concerned the basic invention, described in what was then claim 1 as "a seamless, one-piece, latex girdle in the form of a hollow, flattened, truncated-cone shaped member in normal position, but adapted when pulled into position on the wearer's body to be stretched and to serve as an enclosing flesh-supporting sheath"; claims 6-14 inclusive recited an integral crotch ("panty-girdles") and claims 25, 26 and 27 spoke of the nature of the inner surface, as to both of which more hereafter. In November, 1941, the examiner rejected all the garment claims on the ground of undue multiplicity and also in view of Charnaux' patent No. 1,729,502 for the use of perforated rubber in binding garments, together with Spanel's own patent No. 2,185,527 for seamless latex baby pants.

An amendment of June, 1942, cancelled all previous claims and filed new claims 36 through 44. These new claims again related primarily to the basic invention; the crotch remained in several of the claims but all reference to the different interior surface disappeared. All were again rejected on the basis of the Charnaux and Spanel patents mentioned above, and also Barnes No. 2,125,482 and an Italian patent, Guiseppe No. 258,394, which were stated, along with Spanel's baby pants, to have taught "the use of an integral crotch member."

A further amendment of April, 1943, cancelled all previous claims and added new claims 45-49. Claim 45 con-

tained a more limited statement as to the crotch; claim 49 coupled the basic invention with claims relating to perforation and slight roughening of the interior surface. Spanel's solicitors, in addition to arguing non-anticipation of the crotch by Barnes *et al.* and of the basic invention by Charnaux and the baby-pants, said of Claim 49, "No prior art has been cited pertinent in any respect to this feature." In July, 1943, the Examiner again rejected all claims, adding a citation to Work No. 1,632,017, alleged to have taught "the use of small perforations for applicant's purpose."

Nothing daunted, applicant was back in November, 1943, with three new claims, 50, 51 and 52; the two latter contained references to roughening of the inner surface and are identical with Claims 1 and 2 in the patent as issued; Spanel's solicitors elaborated on the advantages of the roughening and emphasized that "None of the prior art citations suggests any comparable construction." In December, 1943, all these were rejected, the examiner stating that "the rejection may be taken as final for the purpose of appeal, in case applicant so elects."

Applicant did not so elect. Instead he filed, on April 17, 1944, new claims 53 to 56 replacing all the prior claims except 51 and 52. Claim 53 is the final version of the crotch claim and became Claim 3 of the patent as granted. Claim 56 contains reference to pinpoint perforation and roughened inner surface, in substantially the same language as rejected claim 49; it constitutes claim 6 of the patent as granted. Quite inexplicably, this succeeded when all else had failed. On April 28, 1944, the patent issued, including the two "roughening" claims, 51 and 52, previously rejected, the "roughening-perforation" claim 56, formerly rejected when it had been presented as claim 49 in almost the same words, and the narrowed claim 53 as to the crotch.

We set forth in the margin claims 1, 2, 3 and 6 of the patent.[1] As will be seen, claims 1 and 2 relate to an integral one-piece supporting latex girdle with roughened inner surfaces, claim 6 refers to such a garment also having pinpoint perforations distributed on the front and back

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1 "1. An integral one-piece supporting girdle formed of deposited latex sheet material of a strength and shape throughout to apply constrictive force to the flesh around the lower torso of the wearer, the external surfaces of said sheet material being smooth and the inside surfaces thereof being of a slightly roughened matted character for contact with the skin of the wearer.

"2. An integral one-piece supporting girdle formed of deposited latex sheet material of a strength and shape throughout to apply constrictive force to the flesh around the lower torso of the wearer, the internal surfaces of said sheet material being of a matted character and such as to provide in contact with the skin an interconnected cellular formation.

"3. As an article of manufacture, a one-piece deposited latex supporting girdle formed of constricting walls, comprising a constricting front portion and a constricting back portion each formed as normally flat areas the sides of which substantially conform to the outlines of the lower female torso as viewed from the front or back, and narrow areas extending along each side of the girdle, said latter areas being formed with a smoothly curved outwardly convex substantially uniform cross section and serving to integrally join the corresponding sides of said front and back portions and smoothly merging therewith, a readily stretchable narrow crotch area of the deposited latex, extending as a continuous and integral connection between the lower central regions of said front and back portions, the edges of the front of said crotch area extending upwardly and gradually outwardly to merge with and form the lower edges of the middle front portion of the girdle from whence said edges continue outwardly and downwardly to the region of said side areas of the girdle, thereby forming curvilinear cut-out areas at each side of the lower middle front portion, the upper margins of said cut-out areas substantially conforming with the line of juncture of the upper thighs and body of the wearer and said cut-out areas also increasing the effective length of said stretchable crotch area, said crotch area also being shaped and of a length to extend down substantially below the lower margin of the back portion when the girdle is in flat position.

"6. An integral one-piece supporting girdle formed of deposited latex of a strength and shape throughout to apply generally uniform constrictive force to the flesh around the lower torso of the wearer, the front and back areas being formed with 'pin-point' perforations distributed therewover, and the inside surfaces of the latex being of a slightly roughened matted character."

areas, and claim 3 is for such a girdle with a particular type of integral crotch.

Plaintiff placed the seamless latex girdles on the market early in 1940. Exploitation was necessarily curtailed in 1942 due to the shortage of rubber. When manufacture was resumed after the war, the girdles proved a tremendous success. Sales achieved a volume of 3,996,000 units and $10,631,000 in 1950. However, all girdles manufactured and sold by plaintiff during this period had a smooth inner surface, and therefore did not practice the invention as stated in claims 1, 2 and 6 of the patent. The record does not show how many were within claim 3.

About 1950 the defendant, long a prominent manufacturer of girdles, became aware of plaintiff's increasing sales of seamless latex girdles. It arranged to have certain such girdles manufactured for it, and determined, on the advice of counsel, that these would not infringe Spanel's patent. Defendant's panty girdle had a somewhat different form of crotch; and defendant's girdles accomplished the departure from smoothness in the interior surface, desired to promote evaporation and provide a more comfortable "feel," not by abrading the surface of the latex, as Spanel had taught, but by a process, known as "flocking," which applies fine particles of fabric such as cotton, rayon or wool before the latex has hardened. Plaintiff likewise has used "flocking" on all its girdles which do not have smooth inner surfaces; most of the girdles it has made since 1950 have been flocked. As might have been expected, plaintiff did not agree that defendant's variations avoided infringement. Hence this suit.

II. *Validity*

Defendant contends Spanel's patent is invalid. It claims there was no invention in Spanel's basic concept in view of the prior art and particularly because of Charnaux, Young

and Hemm No. 1,923,524; and Spanel's own patent for baby pants, and certainly none in roughening the inner surface, with or without perforations, or in an integral crotch. We agree with the District Court that the patent is valid because of the invention in Spanel's basic concept, although methods for roughening the inner surface of latex were known, perforation also was known and had been specifically taught by Charnaux, and the precise form of integral crotch taught in claim 3 would scarcely meet the statutory test of patentable invention, 35 U. S. C. 101, 103, even though, as the District Court held, 169 F. Supp. 764, it had not been anticipated by Barnes or the baby-pants.

Although the prior art had disclosed the advantages of using rubber in garments for constricting purposes and the feasibility of seamless latex objects in general, Spanel was the first to develop a seamless latex girdle having such features of thickness, tensile strength, shape and size that the garment would produce the desired shaping effect on the wearer's body although, or rather because, the garment was not tailored to the particular form of the body. None of the patents cited by the examiner or relied on by defendant had anticipated this. Charnaux had taught in 1929 that perforating rubber garments would enhance the advantages of rubber for constricting purposes by overcoming the hindrance to cutaneous evaporation presented by smooth unperforated rubber and that varying the size and arrangement of the holes would permit variation in the forces. But this last was the precise opposite of Spanel's concepts of uniformity of force and avoidance of "tailoring"; Charnaux said nothing as to the thickness or strength of the material; and his teaching was the construction of various articles "by means of india-rubber in the form of bands or sheets." Young and Hemm taught

only processes for making perforations—not, as was conceded by defendant's expert, Noble, the art of making a seamless latex girdle. Indeed, Dr. Noble's book "Latex in Industry," published in 1936, three years after Young and Hemm's patent, does not mention the use of latex in making girdles or other foundation garments. Spanel's baby-pants patents were for a seamless latex garment but constriction was neither intended nor desired. While in this field each case must necessarily depend on its own facts, the patentability of Spanel's basic concept is supported by such decisions as *Kurtz* v. *Belle Hat Lining Co.*, 280 Fed. 277 (2d Cir. 1922) and *Franc-Strohmenger & Cowan* v. *Arthur Siegman, Inc.*, 27 F. 2d 785 (2d Cir. 1928), and is not negated by *Deering Milliken & Co.* v. *Temp Resisto Corp.*, 2d Cir., decided January 22, 1960, and the cases there cited, pages 25-30.

Spanel's acceptance of a patent limited to claims wherein his invention was coupled with features not themselves patentable does not render the patent invalid but simply restricts the scope of the monopoly. As said in *International Cellucotton Products Co.* v. *Sterilek Co.*, 94 F. 2d 10, 12 (2d Cir. 1938), "He has done nothing which need prevent him from insisting in support of the claim as allowed that his invention was broader than the examiner supposed." See also *Stromberg Motor Devices Co.* v. *Zenith Carburetor Co.*, 254 Fed. 68, 77 (7th Cir. 1918), *cert. denied* 249 U. S. 605 (1919); *Ethyl Gasoline Co.* v. *Coe*, 139 F. 2d 372 (D. C. Cir. 1943); *Texas Co.* v. *Globe Oil & Refining Co.*, 112 F. Supp. 455, 477-79 (N. D. Ill. 1953), *aff'd* 225 F. 2d 725 (7th Cir. 1955).

III. *Infringement*

(A) We shall first consider plaintiff's appeal from Judge Anderson's conclusion that defendant's girdles that

did not contain a crotch-piece did not infringe claims 1, 3 and 6 since the roughening of their inner surface was produced by flocking rather than by abrading the latex. Plaintiff asserts that a proper interpretation of the patent would include roughening by applying a foreign substance as well as by creating changes in the surface of the latex and in the alternative that it is entitled to relief under the doctrine of equivalents.

Plaintiff's interpretation of the claims to include flocking is inadmissible. Claim 1 refers to a girdle made of "deposited latex sheet material * * * the external surfaces of said sheet material being smooth and the inside surfaces thereof being of a slightly roughened matted character." It is the inside surface of the deposited latex which is to be roughened; nothing suggests the roughened surface is to be part latex and part something else. When claim 2 refers to "the internal surfaces of said sheet material being of a matted character" and claim 6 to "the inside surfaces of the latex being of a slightly roughened matted character," the meaning is the same.[2] Moreover, as said in *Carl Braun, Inc.* v. *Kendall-Lamar Corp.*, 116 F. 2d 663, 665 (2d Cir. 1941), "Infringement is not proved simply by the language used in a claim without regard to the specifications. It must be proved by showing that the claim covers what is alleged to infringe when the claim is read upon the specifications which describe the invention." Here the spe-

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2 Judge Anderson was right in holding, 169 F. Supp. at 765, that the references to perforation in Claim 6 did not place it on any better basis, with respect to infringement, than Claims 1 and 2. For, as stated in the letter of Spanel's solicitors to the patent office dated November 3, 1943, "This claim defines a novel *combination* of features * * * viz., the 'pin-point' perforation feature in conjunction with the feature of forming the inside surfaces of the latex so as to be of a slightly roughened or matted character." See, e.g., *Sears Roebuck & Co.* v. *Minnesota Mining & Mfg. Co.*, 243 F. 2d 136, 140 (4th Cir. 1957). The examiner's repeated references to Charnaux and Work had made it abundantly clear that he would not allow a claim for perforation alone.

cifications state that "according to the invention, the inside surface of the latex walls of the girdle preferably has a less smooth texture than the outside, which texture, being of a more 'matted' character, tends to produce a better feel to the skin and better moisture absorbent qualities," and, even more significantly, that "This roughened inner surface of the girdle may be produced by roughening the surface of the form on which the girdle is generated. The form may be either sand-blasted, etched, or given a rough surface in any suitable manner; e.g., it might be made of unglazed porcelain." There was evidence that in May and June, 1940, plaintiff was experimenting with sand-blasting; nowhere, in the 114 pages of the file, would a searcher encounter a single reference to flocking. Plaintiff can therefore prevail as to infringement on claims 1, 2 and 6 only if this is a proper case for applying the doctrine of equivalents.

Judge Anderson found, 169 F. Supp. at 673, that "even if the doctrine were not ruled out as a matter of law, 'flocking' as used in the accused girdles is not in fact the equivalent of the roughened or matted internal surfaces of the girdles as described in the patent claims." Plaintiff attacks this finding with force. Admittedly the two processes serve the same objectives—promoting evaporation, lessening too close a sticking to the skin, and giving a softer and more comfortable feel. The results are sufficiently indistinguishable that defendant's expert, who was called to demonstrate the difference between them, mistakenly identified a flocked piece of latex as sandblasted and was uncertain whether a sandblasted piece was sandblasted or flocked. And neither the superiority of flocking nor its being more expensive, in an unstated degree, would require a determination that it passed the bounds of equivalence in a proper case. *Johns Manville Corp. v. National Tank Seal Co.*, 49 F. 2d 142, 146 (10th Cir. 1931), *cert. denied* 284 U. S. 654 (1931). We should thus have diffi-

culty in saying that under no circumstances could flocking be deemed an equivalent for abrading the inner surface of latex; however, that issue is an unreal one, arising out of the attempted dichotomy of "equivalence" as between fact and law. The only question of interest to the parties is whether flocking is to be treated as an equivalent under the circumstances here. We think not.

This Court has characterized the doctrine of equivalents as a principle, peculiar to patents, whereby "after all aids to interpretation have been exhausted, and the scope of the claims has been enlarged as far as the words can be stretched, on proper occasions courts make them cover more than their meaning will bear." *Royal Typewriter Co. v. Remington Rand, Inc.*, 168 F. 2d 691, 692 (2d Cir. 1948). Judge Hand there emphasized the necessarily imprecise nature of the doctrine—"All patents are entitled to its benefit to an extent, measured on the one hand by their contribution to the art, and on the other by the degree to which it is necessary to depart from the meaning to reach a just result." His own opinions have shown how small the benefit appropriate in a particular case may be. In *Deitel v. Unique Specialty Corp.*, 54 F. 2d 359, 360 (1931), he refused to apply the doctrine to a patent for a vanity case in the form of a book where the accused article was within the claims save only that the channel members clamping the facing and bottom covers to the frame were integral rather than separate, although "Ordinarily we should not insist upon so slight a difference." This refusal was because "the invention is at best extremely narrow, and we can see no ground for resorting to the doctrine of equivalents when the claims speak plainly and the invention is a trifling step forward." We think a similar result ought follow when, as here, although the invention may have been broader, the applicant drastically narrowed his claims to overcome difficulties in the patent office. In-

deed, Judge Hand's opinion with respect to claim 19 in *International Cellucotton Products* v. *Sterilek Co.*, *supra*, at 11-12, is at least a sign-post along that road. Plaintiff is right in asserting that when it asks us to apply the doctrine of equivalents to include flocking within claims 1, 2 and 6, it is not seeking to produce the result, forbidden by the cases cited below in our discussion of defendant's appeal, of recovering ground that Spanel had ceded in the patent office—as would be the case if it were contending that a smooth inner surface girdle was the equivalent of a roughened one. Nonetheless we think it would be incongruous to apply an equitable doctrine, which is "in misericordiam to relieve those who have failed to express their complete meaning," *Claude Neon Lights* v. *E. Machlett & Son*, 36 F. 2d 574, 576 (2d Cir. 1929), in such a way as to grant to a patentee, who has deliberately accepted a patent limited to a single application of his invention, protection against a defendant who had made a different application—particularly when neither the claims nor even the specifications contain language general enough to comprehend what defendant has done.

We do not read *Graver Tank & Manufacturing Co.* v. *Linde Products Co.*, 339 U. S. 605 (1950), as leading to a contrary conclusion. There the patentees had invented an entirely new type of flux for use in electric welding. The Court applied the doctrine of equivalents to a flux that contained some of the elements included in the claims along with one substance which was not included in the claims held valid, although, as appears from the opinion of the District Court, 75 U. S. P. Q. 231, 238 (N. D. Ind. 1947), it had been disclosed in the specifications and was embraced in a broad claim granted by the patent office but ultimately declared invalid as including inoperative elements, 75 U. S. P. Q. at 237, 336 U. S. 271, 276-77 (1949). See Note, *The Doctrine of Equivalents Revalued*, 19 Geo.

Wash. L. Rev. 491, 502, footnote 49 (1951).' The facts here are quite different.

(B) We come now to defendant's appeal from the district court's decision that its panty girdle infringed claim 3. The final clause in that claim refers to a "crotch area being shaped and of a length to extend down substantially below the lower margin of the back portion when the girdle is in a flat position." The crotch piece in the defendant's girdle is not of that nature, as the District Judge found, 169 F. Supp. 760; defendant's girdle extends further down over the buttocks, thereby giving, as defendant claimed, greater control, and provides the necessary crotch length by a higher curvilinear cut for the front leg openings. The District Judge nevertheless concluded there was infringement by applying, in this instance, the doctrine of equivalents which he had rejected as to claims 1, 2 and 6.

If the original and final wording of claim 3 had been the same, we would not disagree, for the difference here is surely minor. However, we must look at the patent office history and, when we do, we find that even so modest an expansion of the claim by the doctrine of equivalents is precluded by "file-wrapper estoppel." The description of the crotch in allowed claim 3 (originally claim 53) differs from that in rejected claim 45 only in the quoted reference, in the last clause of claim 3, to the crotch area extending below the lower margin of the back. This was a feature not contained in the Barnes patent the examiner had cited and one which the final letter of applicant's patent solicitors

1 The same note concludes (p. 497) that where the limitation to the patentee relied on as a basis for invoking the doctrine of equivalents stems from limitation of claims as a result of prosecution before the patent office, the case "is not such as to warrant aid from the doctrine but instead is more properly viewed as a condition resulting from the patentee's own mistakes of judgment * * * even though the extent of financial loss to the patentee may be extreme."

urged "particularly in its relationship to the other features is clearly novel to the art and important to the success of the invention." It is settled that the rejection of a claim forbids "any interpretation of those secured which leaves them identical with that rejected" or any use of the doctrine of equivalents to that end. *Deitel* v. *Unique Specialty Corp., supra*; *I. T. S. Rubber Co.* v. *Essex Rubber Co.*, 272 U. S. 429, 443-44 (1926); *Smith* v. *Magic City Kennel Club*, 282 U. S. 784, 790 (1931); *Moon* v. *Cabot Shops, Inc.*, 270 F. 2d 539 (9th Cir. 1959), *cert. denied* February 23, 1960.

Plaintiff's counsel, in his effective argument before us, contended the decision of the District Court had left Spanel with the glory of his invention but, so far as concerns defendant, with little else; ours leaves him with even less. Plaintiff's disappointment is understandable. But the result stems from Spanel's decision not to appeal the examiner's rejection of the claims embodying his basic invention but rather to accept a patent with exceedingly narrow and restricted claims. It is not appropriate for us either to speculate as to the causes for his choice or to relieve him from its consequences.

The judgment of the District Court dismissing so much of the complaint as relates to claims 1, 2 and 6 is affirmed; the judgment in favor of plaintiff in respect of claim 3 is reversed with directions to dismiss the complaint.

Judgment

UNITED STATES COURT OF APPEALS

FOR THE SECOND CIRCUIT

At a Stated Term of the United States Court of Appeals, in and for the Second Circuit, held at the United States Courthouse in the City of New York, on the eleventh day of March one thousand nine hundred and sixty.

Present:

HON. J. EDWARD LUMBARD, *Chief Judge*.
HON. LEONARD P. MOORE,
HON. HENRY J. FRIENDLY, *Circuit Judges*.

INTERNATIONAL LATEX CORPORATION,
Plaintiff-Appellant,

v.

THE WARNER BROTHERS COMPANY,
Defendant-Appellant.

Appeal from the United States District Court for the District of Connecticut.

This cause came on to be heard on the transcript of record from the United States District Court for the District of Connecticut, and was argued by counsel.

On Consideration Whereof, it is now hereby ordered, adjudged, and decreed that that part of the judgment of said District Court which dismissed so much of the complaint as relates to claims 1, 2 and 6, be and it hereby is affirmed.

It is further ordered that that part of the judgment of said District Court which is in favor of the plaintiff in respect to claim 3, be and it hereby is reversed with directions to dismiss the complaint in accordance with the opinion of this court, with costs to the defendant-appellant.

A. Daniel Fusaro
Clerk

Back of judgment bears following notations:

"Judgment"
"United States Court of Appeals
Second Circuit
Filed March 11, 1960
Daniel Fusaro, Clerk"

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JAMES R. BROWNING, Clerk

IN THE

Supreme Court of the United States

OCTOBER TERM, 1959

No. ~~992~~ 132

INTERNATIONAL LATEX CORPORATION,
Petitioner.

v.

THE WARNER BROTHERS COMPANY,
Respondent.

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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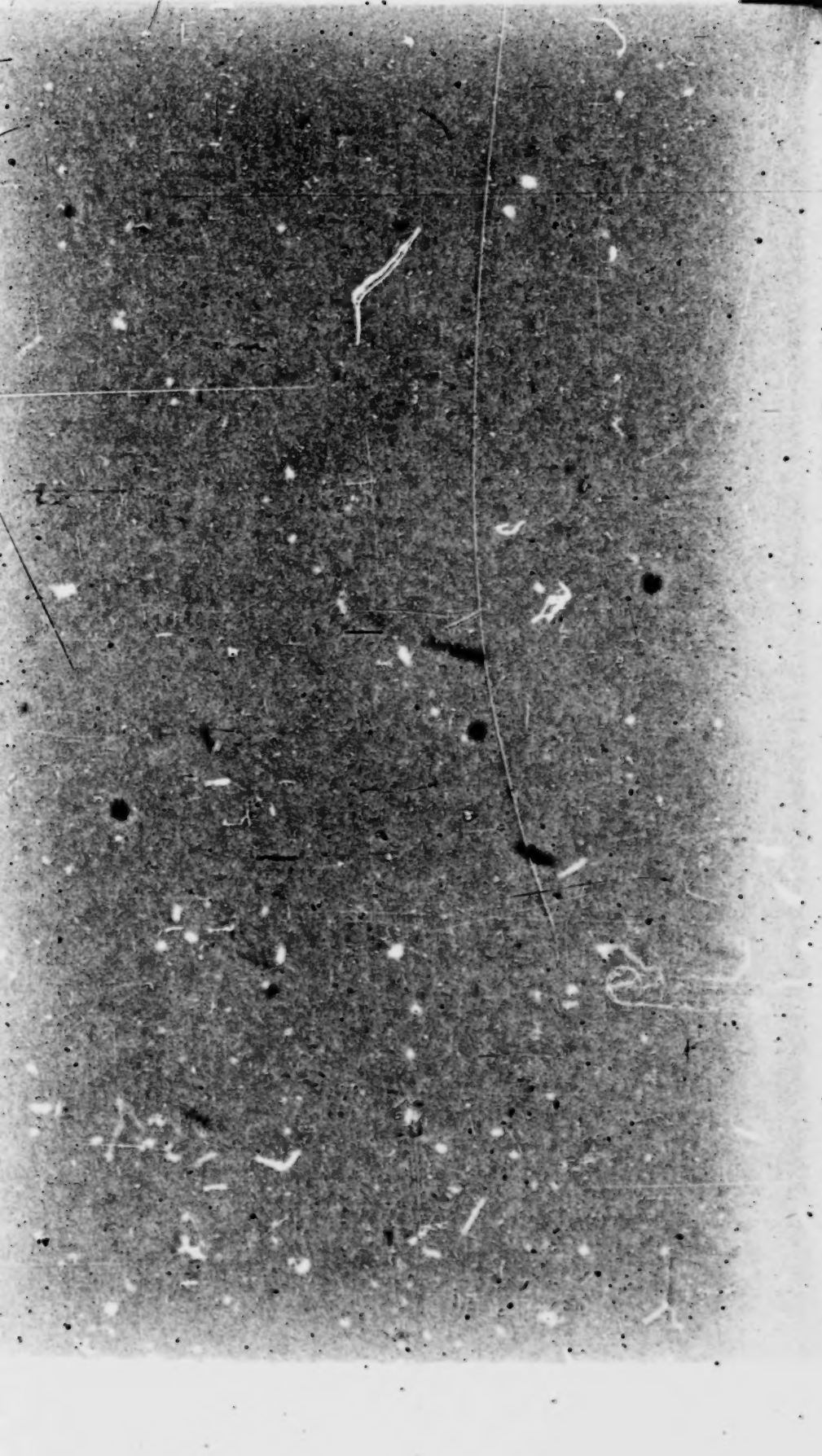
June, 1960



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IN THE

Supreme Court of the United States

OCTOBER TERM, 1959

INTERNATIONAL LATEX CORPORATION, *Petitioner*, v. THE WARNER BROTHERS COMPANY, *Respondent.*	No. 992

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

This is an ordinary patent suit.

The petition asks for review of the question of the fact finding of noninfringement of claims 1, 2 and 6 of a Spanel patent 2,360,736, owned by petitioner, application filed June 26, 1940 and issued October 17, 1944. The patent relates to rubber girdles, or corsets, and expires next year.

The district court and the Court of Appeals each found that these claims were not infringed.

There is no conflict of decisions.

There is no question of general interest or public importance.

1. Opinions below.

The Connecticut district court (Judge Anderson) decided that all four patent claims then in suit, 1, 2, 3 and 6, were valid, that claims 1, 2 and 6 were not infringed, and that claim 3 was infringed, 169 F. Supp. 755.

The Court of Appeals for the Second Circuit (Circuit Judges Lumbard, Moore and Friendly) affirmed except

that claim 3 was found not infringed, 2 Cir., 276 F. 2d 557.

Plaintiff filed a petition for rehearing with respect to only claims 1, 2 and 6. The Court of Appeals, unanimously, denied this petition on March 29, 1960.

The present petition was not filed until June 8, 1960.

2. Jurisdiction.

This Court has jurisdiction, by Title 28 USCA, Sec. 1254(1), but does not exercise it for such a case as here presented.

Keller v. *Adams-Campbell Company*, 264 U. S. 314, 319:

> "Such an ordinary patent case, with the usual issues of invention, breadth of claims, and non-infringement, this Court will not bring here by certiorari unless it be necessary to reconcile decisions of Circuit Courts of Appeal on the same patent."

Magnum Import Co. v. *Coty*, 262 U. S. 159, 163:

> "The jurisdiction to bring up cases by certiorari from the Circuit Courts of Appeals was given for two purposes; first, to secure uniformity of decision between those courts in the nine circuits; and, second, to bring up cases involving questions of importance which it is in the public interest to have decided by this court of last resort. The jurisdiction was not conferred upon this court merely to give the defeated party in the Circuit Court of Appeals another hearing."

Statement of the Case and Argument.

The patent describes a latex dipped girdle, and three subsidiary features which can be used, if desired.

Claims 1, 2 and 6 of the Spanel patent, for one of these features, are the subject of the petition.

In the prosecution of the application, claims were presented to the broad concept of making a rubber girdle by dipping a girdle shaped mold (form) into a tank of latex fluid, withdrawing the mold, and stripping the coagulated latex in the shape of a girdle. All such claims were rejected, and applicant, instead of appealing, acquiesced in the decision by accepting the six narrow claims of the patent.

Each claim is based upon the use, in a latex dipped girdle, of a specific feature. The claims were granted only because of such features. Claim 6 has the feature of a roughened inner (next to the skin) latex surface; claim 3, a long crotch; and claims 4 and 5, garters integral with the girdle.

Only claims 1, 2 and 6, which are substantially the same, require consideration here.

A smooth rubber surface next to the skin is clammy, cold and uncomfortable. Petitioner, realizing this, proposed to make the rubber more comfortable by roughening it, so that the girdles would have rough rubber (latex) inner surfaces, next to the skin. Accordingly, shortly before the patent application was filed, petitioner sand-blasted one surface of the girdle molds (forms), thus obtaining girdles with roughened rubber inner surfaces (stipulation, deft's. Ex. H; Deft's. App. 83a, 86a, 87a). The application as filed, and the patent describe this roughened rubber surface (pat., p. 6, first col., ll. 19-21, 29-35; sec. col., ll. 14, 15). It is the subject of claims 1, 2 and 6.

However, apparently plaintiff discovered some time after the application was filed in June, 1940, that rough rubber next to the skin was, if not worse than smooth rubber, because the rough rubber clung closer to the skin, at least no better. Plaintiff has never sold a girdle with a rough rubber inner surface.

Beginning in 1939 and through 1950, all girdles sold by plaintiff, totaling about 12 million girdles (finding of fact,

PA 376a), had smooth inner surfaces (stipulation, deft's. Ex., DA 82a). Although there was a demand for latex dipped girdles, by the purchasers of plaintiff's latex dipped baby pants and by others, it is plain that these large sales, on which petitioner relied, did not establish commercial success of claims 1, 2 and 6.

A. The idea of latex dipped girdles was not a patentable invention, and was suggested to Spanel by users of latex dipped baby pants.

Petitioner contends that the alleged invention of claims 1, 2 and 6 "advanced the art substantially" (petit., p. 7); and was "a concededly significant invention" (id., p. 10), although respondent has always denied, and now denies that it was either "significant" or an "invention". The record shows that, even if claims 1, 2 and 6 rise to the dignity of a patentable invention "The case is one where, in view of the state of the art, the invention must be restricted to the form shown and described by the patentee", *Duff* v. *Sterling Pump Co.*, 107 U. S. 636, 639; *General Bronze* v. *Cupples Products*, 8 Cir., 189 F. 2d 154, 159, etc., etc.

The art in the present case includes a widespread knowledge of making rubber articles, by dipping molds, pressing in molds, spraying, etc. Such articles were made either from rubber particles obtained from the original latex fluid, or directly from the latex fluid, in which latter case they were often referred to as "latex rubber" or "latex".

Latex dipping was used to make many kinds of articles, such as gloves, shoes, bathing caps, baby pants, etc., etc. (deft's. Ex. A, PA 367a-369a). Prior to 1940, petitioner made and sold latex dipped baby pants, which were made the same way as latex dipped girdles. A mold (form) was dipped into a tank of latex fluid, the mold was withdrawn and the coagulated latex was stripped from the mold. Purchasers of petitioner's baby pants suggested to petitioner

that it add girdles to its line, which petitioner then did, using the same apparatus and process as in making baby pants (DA 80a, 82a). That was not patentable invention.

The prior patents of Young et al., 1,923,524 (PA 284a), Charnaux 1,729,502 (PA 267a) and Clark 2,196,492 (PA 286a), all disclose rubber girdles or corsets. The courts below did not think that they invalidated the broad concept of the Spanel patent because of differences that respondent believes were immaterial. But, whether or not the patents were full anticipations, they clearly established that the idea of making girdles or corsets of rubber, instead of fabric, was not new in 1939, and, therefore, that subsequent patent claims should not be broadly construed as for a primary invention.

B. The Patent Office decided that the broad concept of a latex dipped girdle was unpatentable, and reluctantly allowed only specific claims, including claims 1, 2 and 6.

The application had a long and troubled career in the Patent Office, because the examiner took a dim view of there being any invention in any of the claims urged for patenting. It was only after repeated and lengthy arguments that finally he allowed claims 1, 2 and 6, and the other claims in the patent. Briefly, the application was filed June 26, 1940 with 35 claims (file history, deft's. Ex. L); examiner's action of November 8, 1941 rejected all claims (the application then became abandoned because of lack of timely response, but was revived); amendment of June 9, 1942 cancelled all claims and "new claims" 36 through 44 were filed (id., p. 59); action of October 24, 1942 rejected all claims (id., p. 71); amendment of April 6, 1943 cancelled all claims and added "new claims" 45 through 49 (id., p. 84); amendments of November 5, and 12, 1943, amended claims and argued for allowance (id., pp. 85 and 92); action of December 4, 1943 rejected all

claims (id. p. 97); and this rejection was then acquiesced in by a final amendment of April 17, 1944, cancelling all claims and substituting the narrow, limited claims now in the patent (id. p. 99), with immediate allowance on April 28, 1944 (id. 108).

Allowance of claims 1, 2 and 6 did not mean that the examiner thought it was patentable invention to have a rough rubber (latex) inner surface, but only that there was enough doubt to entitle the patentee—

> "to assert his *prima facie** right against infringers who may, in their defense, raise the question of the validity of the patent, and have the same finally adjudicated in the light of a full presentation and consideration of all the evidence attainable in respect of anticipation, prior knowledge, use, and the like", In re Thomson, 26 App. D. C. 419, 425; 120 O. G. 2756 (1906); *In re Meyer*, CCPA, 123 F. 2d 1021, 1023 (1941), and *In re de Groote*, CCPA, 127 F. 2d 322 (1942).

Undoubtedly, if the examiner had known that the subject of claims 1, 2 and 6 had never been used when petitioner's patent attorney represented that this was one of the reasons for "the very remarkable commercial success of the invention" (id. p. 86) he never would have allowed the claims.

With respect to the broad concept and claims 1, 2 and 6, the Patent Office decided that the broad concept was not patentable, repeatedly rejecting claims for this idea, such as claims 1 and 42:

> "1. As an article of manufacture, a *seamless, one-piece, latex girdle* in the form of a hollow flattened, truncated-cone shaped member in normal position, but adapted when pulled into position on the wearer's body to be stretched and to serve as an enclosing flesh-supporting sheath"

*Emphasis ours throughout.

> "42. As an article of manufacture, a *seamless, one-piece deposited latex supporting girdle* having a constricting front surface portion, and a constricting back surface portion, said portions smoothly merging into one another to provide transversely and longitudinally curved side portions".

The Patent Office refused to recognize invention in these (or similar) claims to the "broad concept", declaring that they did not "involve invention" (id., p. 41); "the particular material employed and the thickness thereof are not matters of invention" (id., p. 71); "To combine the teachings of these patentees does not amount to invention" (id., p. 84); and "nothing patentably novel" (id., p. 97).

After all the claims in the case, including all claims for Spanel's "broad concept", had been finally rejected, applicant had the statutory right to appeal this adverse decision and thereby obtain, by reversal, claims to the broad concept.

I. T. S. Co. v. *Esser Co.*, 272 U. S. 429:

> "If dissatisfied with the rejection he should pursue his remedy by appeal; and where, in order to get his patent, he accepts one with a narrower claim, he is bound by it" (p. 443).
>
> "So where an applicant whose claim is rejected on reference to a prior patent, without objection or appeal, voluntarily restricts himself by an amendment of his claim to a specific structure, having thus narrowed his claim in order to obtain a patent, he 'may not by construction, or by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments which amount to a disclaimer'. *Weber Elec. Co.* v. *Freeman Elec. Co.*, 256 U. S. 668, 677." (p. 444).

In the present case, petitioner did not appeal the rejection, but acquiesced in it, by cancelling all claims, and submitting the narrow and limited claims of the patent, with the statement that they—

> "are not broadly directed to the mere use of an integral deposited latex construction, or to a mere change of material. Instead, the present claims are each limited to *specific features* which make practical such an integral deposited latex girdle, these features being the ones which are believed to have made possible *the very remarkable commercial success of the invention*" (pp. 85, 86).

The fact was that the "specific feature" of claims 1, 2 and 6 had not then, and never has been, used.

The courts below apparently did not recognize that "commercial success without invention will not make patentability", as said by this Court in *A. & P. Tea Co.* v. *Supermarket*, 340 U. S. 147, 153, where a patent was held invalid after two concurring decisions below that the patent was valid. In the present case, even if there had been "commercial success" of latex dipped girdles, that is not enough —the success must be "for the device defined by the" claims, *Altoona Publix Theatres* v. *American Tri-Ergon*, 294 U. S. 477, 488.

Claims 1, 2 and 6 were not entitled to "commercial success" to help their patentability, because millions of latex dipped girdles were sold without their presence. Respondent believes now, as heretofore, that these claims are invalid for want of invention, and that they never would have been allowed by the Patent Office if it had known that they were not used in plaintiff's girdles.

C. The fact issue of the doctrine of equivalents was found, correctly, for respondent in the trial court and affirmed by the Court of Appeals.

The petition asks this Court to review the findings of fact below that claims 1, 2 and 6 were not entitled to "the doctrine of equivalents" (petition, pp. 2, 6, 11, 14).

But equivalency is "a determination of fact", it is "an issue of fact", and that issue was found, on ample evidence, against petitioner, by a trial court that saw the witnesses, observed tests and was affirmed by a unanimous Court of Appeals.

Graver Mfg. Co. v. *Linde Co.*, 339 U. S. 605.

> "What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case" (p. 609).
>
> "A finding of equivalence is a determination of fact. Proof can be made in any form; through testimony of experts or others versed in the technology; by documents, including texts and treatises; and, of course, by the disclosures of the prior art. Like any other issue of fact, final determination requires a balancing of credibility, persuasiveness and weight of evidence. It is to be decided by the trial court and that court's decision, under general principles of appellate review, should not be disturbed unless clearly erroneous. Particularly is this so in a field where so much depends upon familiarity with specific scientific problems and principles not usually contained in the general storehouse of knowledge and experience" (pp. 609-610).

The doctrine of equivalents is an exception, to the general rule that the patentee, who writes and proposes claims in his own language, must clearly and unequivocally warn the public of what he claims.

White v. *Dunbar*, 119 U. S. 47, 52:

> "The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms."

United Carbon Co. v. *Binney & Smith Co.*, 317 U. S. 228, 236:

> "The statutory requirement of particularity and distinctiveness in claims is met only when they clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise. The zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal foreclosure of the field."

The exception of the doctrine of equivalency is applied only in cases of meritorious inventions, and then, only when—

> "two devices do the same work in substantially the same way, and accomplish substantially the same result, *Machine Co.* v. *Murphy*, 97 U. S. 120, 125" *Sanitary Refrigerator Co.* v. *Winters*, 280 U. S. 30, 42.

The district court, trier of the facts, found that defendant's girdles were not the equivalent of the girdles described in claims 1, 2 and 6. Defendant's fabric lining, called "flock", composed of comminuted fibres of cotton and the like, was not the same as roughened rubber, and did not act the same in a girdle. The Court of Appeals concurred, and denied a rehearing.

These findings should stand, unless clearly erroneous, especially as they were based upon the credibility of witnesses appearing before the judge, tests made in his presence and both physical and documentary exhibits, Fed. Rules Civ. Proc., 52a; *United States* v. *Gypsum Co.*, 333 U. S. 364, 394-395; *Commissioner* v. *Duberstein*, U. S. , 20 Sup. Ct. 1633, 1644 (June 13, 1960).

The fact evidence concerning equivalency included:

(1) The Spanel patent.

(2) Its Patent Office history.

(3) Many patents and publications.

(4) Defendant's alleged infringing girdles.

(5) Plaintiff's three specimens of sand-blasted and flocked material (plff's. Exs. 223, 224 and 226).

(6) Plaintiff's two small specimens of latex (Exs. 251-F and S).

(7) A stipulation concerning plaintiff's sand-blasted molds (deft's. Ex. H).

(8) Plaintiff's admissions concerning sand-blasted molds (deft's. Ex. I-I).

(9) The oral testimony of Ambrose, plaintiff's witness (PA 103a, 104a, 105a, 110a, 111a, and 117a).

(10) The oral testimony of Noble, defendant's witness (PA 190a through 202a; DA 19a).

(11) Plaintiff's tests in the trial court, witnessed by the trial judge (PA 192a-202a; 206a-214a).

Testimony concerning the differences, as a practical matter, between roughened rubber and a fabric lining on rubber included the following:

Flock fibres have a wicklike action in absorbing moisture,—roughened rubber does not (Noble, PA 192a).

Flock has "greater comfort" (Ambrose, DA 5a). Rubber next to the skin feels cold and clammy. A fabric lining does not.

Flock costs more and is more difficult to apply to a girdle than sand-blasting a form (Ambrose, DA 4a). Sand-blasted forms can be used "for a long time", to make many

girdles (Ambrose, DA 3a, 4a), and a lining of flock is useful for only one girdle.

There is danger of explosion when the finely divided flock fibres are put on the girdle (Ambrose, DA, 4a), which is not so with sand-blasted forms.

No rubber article in the record, including the rubber girdles of defendant, plaintiff, Kleinert, Miss Hollywood and Diana, have rough rubber inner surfaces next to the body—all have flock. Here, as in *New York Trust* v. *Eisner*, 256 U. S. 345, 349, a "page of history is worth a volume of logic".

Conclusion.

Petitioner, a private litigant, has had its day in court, on an ordinary patent, of minor importance. There is no conflict of circuits. The only error complained of is that the concurrent findings by the courts below were misapplications of the doctrine of equivalents to the totality of the unique and special facts in this particular case. They were not.

The petition should be denied.

Respectfully submitted,

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June, 1960

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IN THE

Supreme Court of the United States

Term, 19

No. [redacted] 1959

INTERNATIONAL LATEX CORPORATION,

Petitioner,

v.

THE WARNER BROTHERS COMPANY,

Respondent.

PETITIONER'S REPLY

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No. 992

INTERNATIONAL LATEX CORPORATION,
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THE WARNER BROTHERS COMPANY,
Respondent.

PETITIONER'S REPLY

Respondent misrepresents that the petition here seeks review of questions of fact. Nothing could be further from the truth.

The petition seeks review of an important question of patent law and it is based on the ground that the Court of Appeals has decided a federal question in a way in conflict with applicable decisions of this Court.

The arbitrary denial by the Court below of the benefit of the doctrine of equivalents in such cases as this one is in substantial effect a denial of the doctrine itself. The decision therefore sets a precedent having the potentiality

to confuse the law with serious consequence to most existing patents. The decision therefore goes beyond the interest of the particular litigants here involved.

It seems to us that respondent tacitly acknowledges the existence of this conflict of law by the complete avoidance, in its brief, of any discussion of this question although it is the entire basis of our petition.

Petitioner fully accepts the fact findings of the lower court.

As to the fact of patentability, both the courts below found satisfactory evidence that a significant invention had been made and in vigorous comments told why (District Court, I, 382a-384a; Court of Appeals; Addendum to Petition, 104-5a and 110-111a and see also Note 1, Appendix to Petition).

As to the fact of equivalency, contrary to the respondent's suggestion (Br. p. 10), the Court of Appeals withheld its approval of the District Court's finding. It recognized equivalency as a matter of function and purpose but denied to the claims the benefit of the doctrine of equivalents on the broad ground that claims restricted in the Patent Office are not entitled to its benefit, even though the matter sought to be reached was nowhere included in the Patent Office discussion (see our petition pp. 9-10).

This is the ground upon which Petitioner respectfully urges a review by this Court.

Respectfully submitted,

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New York, N. Y., July 1, 1960.